

REMARKS

Applicant respectfully requests reconsideration of the present application in view of the foregoing amendments and in view of the reasons that follow.

In the outstanding Office Action of January 24, 2008, the Examiner asserted that claims 8-20 were rejected under 35 U.S.C. § 101 because the claimed invention is allegedly directed to non-statutory subject matter. Applicant traverses the rejection for the reasons set forth below.

With regard to claims 8-20 of the present application, the Examiner indicated in the March 12, 2007 Non-Final Office Action that, e.g.:

Regarding claim 8, recites a device but it appears reasonable to interpret this device by one of ordinary skill in the art as software, per se. Applicant's specification provides no explicit and deliberate definition of the components ("consumer application", provider application", "applicant interworking framework") that make up the device other than they could be software components, which are directed to function description material, per se, and are therefore nonstatutory.

Applicant's May 14, 2007 response presented arguments indicating that, contrary to the Examiner's assertions, the subject matter recited in claims 8-20 of the present application are statutory in light of 35 U.S.C. § 101. In the July 24, 2007 Final Office Action, the Examiner again rejected claims 8-20 under 35 U.S.C. § 101, maintaining that the subject matter recited therein is nonstatutory, without answering and/or rebutting any of Applicant's previous arguments. In response to the July 24, 2007 Final Office Action, Applicant submitted a Pre-Appeal Brief Request for Review on October 24, 2007 again discussing at length why claims 8-20 of the present application recite statutory subject. Applicant was informed on November 30, 2007 that prosecution would be reopened and a new Office Action would be issued. However, claims 8-20 have once again been rejected under 35 U.S.C. § 101 in the outstanding Non-Final Office Action and once again, the Examiner has failed to respond substantively to any of Applicant's arguments regarding this rejection.

In light of the Examiner's repeated rejection of claims 8-20 under 35 U.S.C. § 101, Applicant directs the Examiner to Section 707.07(f) of the MPEP which states that "[W]here

the applicant traverses any rejection, the examiner should, if he or she repeats the rejection, take note of the applicant's argument and answer the substance of it." (emphasis added). In this instance, although the Examiner maintained his rejection, he failed to substantially answer or rebut Applicant's arguments or further provide evidence to support his position that claims 8-20 of the present application recite nonstatutory subject matter. Therefore, Applicant respectfully submits that the outstanding Official Action is improper with respect to claims 8-20 in that it is unresponsive to Applicant's arguments and in violation of Section 707(f) of the MPEP.

Additionally, Applicant incorporates herein by reference in their entirety those arguments directed to claims 8-20 filed in Applicant's previous response of May 14, 2007 at pages 2-4 and in Applicant's previous Pre-Appeal Brief Request for Review of October 24, 2007 at pages 1-3. That is, the present application is replete with references to menu service interfaces, user interfaces (UI), menu items, phones, etc. upon which the various embodiments described in the present application can be implemented. (*See, e.g.,* Figs. 2 and 5, Para. [0004], [0030], [0038], [0040], [0044], [0046], and [0061] of the present application). Therefore, it should be abundantly clear that the methods described in claims 1-20 are not software per se, and therefore, contrary to the Examiner's assertions, do meet the statutory requirement(s) of 35 U.S.C. § 101. Moreover, Applicant submits that the processes described in, e.g., claims 8-20 of the present application are "acts" that are being performed. Applicant is at a loss to how any other characterization can be given to a method, other than acts that are performed. Further still, Applicant submits that even if the claimed subject matter of, e.g., claims 8-20 could be characterized as software per se, the subject matter is not automatically deemed to be non-statutory subject matter because they recite methods that produce concrete, tangible, useful results in accordance with *State Street Bank & Trust v. Signature Financial Group, Inc.* 149 F.3d 1368, 47 USPQ2d 1569 (Fed. Cir. 1998).

Claims 1-3 and 5-23 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 7,194,743 (Hayton et al.) Applicant traverse the rejection for the reasons set forth below.

With regard to independent claims 1, 8, and 17 of the present application, the Examiner asserted that Hayton et al. teaches all of the required limitations recited therein. Applicant disagrees. In particular, Applicant submits that Hayton et al. fails to teach or suggest providing a feature to a consumer application, requesting a feature matching a consumer interest from an application interworking framework, and/or a provider application where an interface is provided for the provider application and a consumer application such that a feature interest is matched with a feature from the provider application.

Hayton et al. is directed to a system and method of providing, e.g., remote access to an application. That is, Hayton et al. teaches providing a user-interface (UI) portion of an application to either the same machine on which the application is executing, or on another machine remote from the machine executing the application. (*See, e.g.*, Abstract and Column 2, lines 44-52). A user that is, e.g., customizing a UI 42, such as a web page, may choose UI elements 46 and associate those chosen UI elements 46 with one or more properties of an application component 34 by indicating one or more property paths. (*See, e.g.*, Figures 1-4 and Column 11, lines 3-15). Additionally, Hayton et al. suggests that an application 26 (which includes, e.g., the application components 34), can create or delete properties. (*See, e.g.*, Column 12, lines 44-50). Hence, Hayton et al. is merely directed to a single application (e.g., the server application 26) that has a client UI 42 which can be “customized” with various UI elements 46.

In contrast to the above-teachings of Hayton et al., various embodiments disclosed in independent claims 1, 18, and 17 of the present application, require adding features to a consumer application, where the feature matches that which a consumer wishes to have. As described above, Hayton et al. merely teaches adding a UI element to the UI 42, not a feature to application 26. (*See, e.g.*, Figure 4 and Column 20, lines 21-64).

With regard to, e.g., claim 1, for example, the feature matching a consumer interest is requested from an application interworking framework. It appears from the Examiner’s assertions that the Examiner is reading, e.g., the property connector API 22 as the claimed application interworking framework. (*See, e.g.*, Column 11, lines 49-52 of Hayton et al. where it is described that upon execution of the property connector API 22, a UI element 46

is mapped to an application component 34). However, nowhere in the portions of Hayton et al. cited by the Examiner, nor anywhere else in Hayton et al., is it taught or even contemplated that any request is made of the property connector API 22. Moreover, claim 1 further requires, e.g., identifying a provider and providing a feature if the provider is identified. Applicant submits that nowhere in Hayton et al. is it described or otherwise suggested that a provider is identified. As noted above, Hayton et al. is directed to modifying, e.g., a UI 42, where the same server process 14/application 26 is always associated with the UI 42. Hence, there is no need for the system and method of Hayton et al. to ever “identify a provider” as required by independent claim 1 of the present application.

In reference to claims 8 and 27, for example, both a consumer application (which, e.g., publishes a feature interest indicating what features a consumer application desires to have) and a provider application that has the feature are required. As described above, Hayton et al. merely teaches a single application, e.g., the server application 26. Therefore, Hayton et al. cannot anticipate both of the claimed consumer application and provider application, because again, Hayton et al. is directed merely to a single application 26 that may have a configurable UI 42.

As to claim 21 of the present application, for example, storing a user interface element corresponding to the consumer application interest is required. As described above, Hayton et al. does not teach any sort of consumer application interest, only a UI element that a user may be interested in utilizing in the UI 42. Furthermore, the section of Hayton et al. that the Examiner cited to support his position, e.g., Column 16, lines 31-32, does not in any way anticipate this claimed feature of the present application. That is, Column 16, lines 31-32 merely indicate that values corresponding to application components 34 are stored. In contrast, claim 21 of the present application requires that a user interface element is stored.

Moreover, claim 21 requires communicating the user interface element to an application interworking framework. However, Hayton et al. does not teach or even contemplate such an operation. As evidenced by the Examiner’s assertions at pages 9-10 of the outstanding Office Action, Hayton et al. merely teaches that the “user interface portion of the application can be delivered to the computer user...” and that the server portion 22b

transmits to the client portion 22a any change...” As described above, a user of Hayton et al. chooses a UI element and, e.g., associates that UI element with a state of property of an application component. However, communicating that UI element to the property connector API 22 is never taught or suggested. Second, as described above, it appears that the Examiner has interpreted the property connector API 22 of Hayton et al. as allegedly reading on the claimed application interworking framework. Given this interpretation, the operation involving “the server portion 22b transmits to the client portion 22a” would be analogous to the property connector API 22 communicating with itself because the server portion 22b and client portion 22a are both a part of the property connector API 22, and hence do nothing to support the Examiner’s assertions. (*See, e.g.,* Column 11, lines 23-30 of Hayton et al.)

Even if one of the server portion 22b or the client portion 22a could be interpreted as being analogous to the claimed application interworking framework, Hayton et al. still fails to read on claim 21 of the present application. That is, Column 18, lines 57-60, from which the description “the server portion 22b transmits to the client portion 22a any change...” is quoted teaches that change events associated with property paths are communicated. Additionally, Column 18, lines 60-65 describe that in association with the server portion 22b transmitting change event information to the client portion 22a, the UI elements are notified. Therefore, Applicant again submits that if the change information transferred between the server portion 22b and client portion 22a is being utilized to, e.g., notify the UI elements, it cannot be the UI elements that are being communicated. In contrast, claim 21 requires that a user interface element is communicated to an application interworking framework.

Applicant further submits that the Examiner has mischaracterized the teachings of Hayton et al. with respect to dependent claims 2, 3, 5-7, 9-16, 18-20, 22, and 23 of the present application. For example and with respect to, e.g., dependent claims 2, 12, and 18, the Examiner asserted that the claimed limitation of “using generic parameter in application interworking framework application programming interfaces (API)” is taught by Hayton et al. at Figure 1 and Column 11, lines 50-52. However, as noted by the Examiner at page 5 of the outstanding Office Action, Column 11, lines 50-52 merely teach, e.g., that the “API 22 maps each dynamic user-interface element 46 to a property 38 of an application component 34 using the associated property path.” Applicant cannot find or deduce where or what

element of the quoted language of Hayton et al. is being interpreted as referring to generic parameters in application interworking framework application APIs. Therefore, Applicant respectfully requests that if the Examiner wishes to maintain this rejection, that he explain/point out with specificity, how the teachings of Hayton et al. are being interpreted to allegedly read on the claimed limitations of, e.g., claims 2, 12, and 18 of the present application.

With regard to, e.g., claim 11, the Examiner asserted that the claimed limitation “wherein the new consumer application integrates into the device as if part of an original group of software applications for the device” is allegedly read on by Hayton et al. at Column 10, lines 66-67. Column 10, lines 66-67 of Hayton et al., as quoted by the Examiner merely states that “[t]he client process 18 produces a user-interface (‘UI’) 42 that is displayed to a user.” Applicant submits that producing a UI that is displayed to a user suggests nothing even remotely associated with integrating a new consumer application as if part of an original group of software applications as required by, e.g., claim 11 of the present application. First, and as described above, Hayton et al. fails to teach the integration of any new consumer application. Rather, Hayton et al. is directed to implementing UI elements in a UI 42. Second, the fact that a UI 42 is displayed indicates nothing regarding how a new application is integrated into an original group of applications as if it were an original part thereof. There is simply no language or implicit indication in Hayton et al. that suggests such a feature.

Additionally, Applicant submits that because dependent claims 2, 3, 5-7, 9-16, 18-20, 22, and 23 are dependent upon independent claims 1, 8, 17, and 21 of the present application, Hayton et al. fails to teach all of the required limitations recited in the dependent claims for at least the same reasons as discussed above with regard to, e.g., claims 1, 8, 17, and 21.

Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Hayton et al. in view of International Patent Application No. WO 00/58855 (Gudmunson). With regard to claim 4, the Examiner correctly recognized that Hayton et al. does not teach the use of dynamic link libraries. However, the Examiner asserted that Gudmunson cures this deficiency. Applicant submits that because Gudmunson was applied by the Examiner solely for purpose of evidencing the use of DLLs, Gudmunson cannot cure the deficiencies of

Hayton et al. described above. Therefore, because claim 4 depends from independent claim 1 of the present application, Applicant submits that the alleged combination of Hayton et al. and Gudmunson still fail to teach all of the required limitations of claim 4 for at least the same reasons as discussed above.

Additionally, at page 2, sections 1 and 3 of the outstanding Office Action, the Examiner asserted that “[t]his action is in response to the amendment filed 12/14/2007” and “[t]he rejection to claims 1-23 under 103(a) of previous action is withdrawn in view of Applicant’s amendment.” Applicant submits that amendments were submitted on December 14, 2006, not December 14, 2007 for clarification and consistency purposes. Moreover, because Applicant filed a Pre-Appeal Brief Request for Review on October 24, 2007 to which the outstanding Office Action is responding to, Applicant submits that it is a mischaracterization of the prosecution history to assert that the previous Office Action of July 24, 2007 was withdrawn in view of Applicant’s amendments.

Because none of the references cited by the Examiner, either separately or in combination with each other, teach all of the required limitations of independent claims 1, 8, 17, and 21 of the present application, Applicant submits that each of these independent claims are patentable over this prior art. Furthermore, because dependent claims 2-7, 9-16, 18-20, 22, and 23 are each directly or indirectly dependent upon independent claims 1, 8, 17, and 21, Applicant submits that each of these claims are allowable for at least the same reasons as discussed above.

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated,

otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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